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10/500,836	07/07/2004	Lourens George Bordewijk	2019-1002	8388
<div>465 7590 01/28/2009</div> <div>YOUNG & THOMPSON 209 Madison Street Suite 500 ALEXANDRIA, VA 22314</div>				
EXAMINER				
LUKS, JEREMY AUSTIN				
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2837				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/500,836

Applicant(s)

BORDEWIJK, LOURENS GEORGE

Examiner

JEREMY LUKS

Art Unit

2837

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12, 17, 19, 22-27, 29 and 31-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12, 17, 19, 22-27, 29 and 31-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/24/08 has been entered.

Claim Objections - 35 USC § 112

2. Claims 24 and 32 recites the limitation "the internal part" in line 13, page 6 of the amended claim 24 from 11/24/08, and line 3 of claim 32. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 12, 19, 22-27 and 31-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ambrose (4,852,177) in view of Levin (6,144,750).

With respect to Claim 12, Ambrose teaches a hearing aid (Figure 9) to be placed in the auditory canal of a patient (Col. 3, Lines 11-13), the hearing aid comprising a standard part (Figure 6, #11) configured to fit near an outside of an auditory canal of a patient, the standard part (11) accommodating a microphone (Figure 10, #15), an amplifier (Figure 11, #6), a loudspeaker (5) (Col. 3, Lines 27-30) and a battery compartment (Col. 5, Lines 45-49), and a dedicated part (1) configured to fit in the auditory canal, and facing an eardrum of one of a left ear and a right ear of a patient (Col. 3, Lines 11-13), the dedicated part (1) being adapted to specific geometry of the auditory canal of one of a left ear and a right ear of the patient (Col. 2, Lines 13-18), wherein the dedicated part is provided with sound transmission means (Figure 8, #13) for the transmission of sound from said loudspeaker (5) into the auditory canal, the sound transmission means (13) being adapted to the specific geometry of the auditory canal (Col. 2, Lines 26-28), wherein the standard part (11) has an outer end face (outer surface of member #11, having central aperture), a surface extending across the entirety of said outer end face (of member #11) being symmetrical oval (The Examiner notes that the standard part #11 in Figure 13 appears to be symmetrically oval) and wherein said standard part (11) is configured to connect to said dedicated part (1) regardless of whether said dedicated part (1) is configured to fit in the auditory canal of the left ear or the right ear of the patient (Col. 2, Lines 13-18, 26-28). Ambrose fails to teach the standard part being made of rigid plastic, and the standard part having an outer end face surface provided with a sound aperture for said microphone, said sound aperture being located in the center of the outer end face surface configured to transmit

sound to said microphone. Levin teaches a standard part (Figure 2, #30) being made of rigid plastic (Col. 3, Lines 15-20), and the standard part (30) having an outer end face surface provided with a sound aperture (36) configured to transmit sound to a for a microphone (Col. 2, Lines 44-46), said sound aperture (Figure 24, #36) being located in the center of the outer end face (outer face of plate #30). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the apparatus of Ambrose, with the apparatus of Levin to allow for the sound picked up by the microphone to be more evenly distributed to the center of the hearing aid. Further, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70. Also, it has been held that simple substitution of one known, equivalent element (i.e. a centrally located microphone aperture) for another would have been obvious to one of ordinary skill in the art at the time of the invention to obtain predictable results. KSR International Co. v. Teleflex Inc., 82 USPQ 2d 1385 (2007). Further, it has been held that the recitation than an element is "adapted to," or "configured to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

With respect to Claim 19, Levin teaches comprising a means (Figure 2, #38) for removing the hearing aid from the auditory canal (Col. 2, Lines 42-44), the removing means (38) having a part connected to a standard part (30) when used in combination. Ambrose and Levin fail to teach wherein the means for removing comprises an injection-molded part; however, the method of forming a device is not germane to the

issue of patentability of the device itself. Therefore, this limitation has been given little patentable weight.

With respect to Claim 22, Ambrose teaches wherein the dedicated part (1) is provided with a means (Figure 13, #23) for removing the dedicated part (1) from the auditory canal.

With respect to Claims 23, 32, 34 and 35, Ambrose teaches a hearing aid (Figure 9) comprising a standard part (Figure 6, #11) having an enclosed interior volume housing a microphone (Figure 10, #15), an amplifier (Figure 11, #6), a loudspeaker (5) (Col. 3, Lines 27-30) and a battery compartment (Col. 5, Lines 45-49), and a dedicated part (1) shaped to fit in an auditory canal facing an eardrum of a patient (Col. 3, Lines 11-13), the dedicated part (1) being adapted to specific geometry of the auditory canal of one of a left ear and a right ear of the patient (Col. 2, Lines 13-18), wherein, the dedicated part (1) is comprised of a sound transmitter (Figure 8, #13) for transmitting sound from said loudspeaker (5) into the auditory canal, the sound transmitter (13) adapted to the specific geometry of the auditory canal of one of the left ear and the right ear of the patient (Col. 2, Lines 26-28), and a central axis forming an angle of at least ten degrees to approximately 45 degrees (See Figures 8 and 12) with respect to a longitudinal axis of the standard part (11), the standard part (11) is comprised of an outer end face outer (surface of member #11, having central aperture), and the cross section of an outer boundary of the outer end face of the standard part (11) is mirror symmetrical in outside end view (See Figure 13), the central axis is in a position perpendicular to an end face (near #34) of the dedicated part (1), the longitudinal axis is

in a perpendicular to the outer end face of the standard part (11), and the standard part (11) is configured to connect to the dedicated part (1) regardless of whether the dedicated part (1) is adapted to the auditory canal of the left ear or the right ear of the patient. Ambrose fails to teach the standard part being made of rigid plastic, and the standard part having an outer end face surface provided with a sound aperture for said microphone, said sound aperture being located in the center of the outer end face surface configured to transmit sound to said microphone. Levin teaches a standard part (Figure 2, #30) being made of rigid plastic (Col. 3, Lines 15-20), and the standard part (30) having an outer end face surface provided with a sound aperture (36) configured to transmit sound to a for a microphone (Col. 2, Lines 44-46), said sound aperture (Figure 24, #36) being located in the center of the outer end face (outer face of plate #30). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the apparatus of Ambrose, with the apparatus of Levin to allow for the sound picked up by the microphone to be more evenly distributed to the center of the hearing aid. Further, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70. Also, it has been held that simple substitution of one known, equivalent element (i.e. a centrally located microphone aperture) for another would have been obvious to one of ordinary skill in the art at the time of the invention to obtain predictable results. KSR International Co. v. Teleflex Inc., 82 USPQ 2d 1385 (2007). Further, it has been held that the recitation than an element is "adapted to," or "configured to" perform a function is not a positive limitation but only

requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

With respect to Claim 24, Ambrose teaches a hearing aid (Figure 9) comprising a dedicated part (Figure 13, #1), having an end face (near #34) and an exterior surface (cylindrical surface of #1), and containing only a sound channel (defined by #35) configured to function as a sound transmitter, the exterior surface of the dedicated part (1) configured to fit with a specific geometry of an auditory canal of one of a left ear and a right ear (Col. 2, Lines 26-28); and a standard part (11) electronics and a battery (Col. 5, Lines 45-49), the standard part (11) comprised of an outer end (outer surface having aperture seen in Figure 13), and a connecting part (could be rim element extending from part #11 in Figure 13 for example) connecting the standard part (11) to the dedicated part (1); wherein the dedicated part (1) has a central axis, perpendicular to the end face (near #34) of the dedicated part (1), forming an angle of at least ten degrees with respect to a longitudinal axis, perpendicular to an end face (outer face of #11) of the standard part (11) (angle seen in Figures 8 and 12), wherein the standard part (11) is mirror symmetrical in an end view and wherein the connecting part (could be rim element extending from part #11 in Figure 13 for example) is configured to connect to the dedicated part (1) regardless of whether the dedicated part (10 is configured to fit with the specific geometry of the auditory canal of the left ear or the right ear. Ambrose fails to teach the standard part having an outer end face surface provided with a sound aperture for said microphone, said sound aperture being located in the center of the outer end face surface configured to transmit sound to said microphone; and control

elements on the outer end face of the standard part are disposed in such a symmetrical arrangement around the microphone sound aperture. Levin teaches a standard part (Figure 2, #30) being made of rigid plastic (Col. 3, Lines 15-20), and the standard part (30) having an outer end face surface provided with a sound aperture (36) configured to transmit sound to a for a microphone (Col. 2, Lines 44-46), said sound aperture (Figure 24, #36) being located in the center of the outer end face (outer face of plate #30). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the apparatus of Ambrose, with the apparatus of Levin to allow for the sound picked up by the microphone to be more evenly distributed to the center of the hearing aid. Further, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70. Also, it has been held that simple substitution of one known, equivalent element (i.e. a centrally located microphone aperture) for another would have been obvious to one of ordinary skill in the art at the time of the invention to obtain predictable results. KSR International Co. v. Teleflex Inc., 82 USPQ 2d 1385 (2007). Further, it has been held that the recitation than an element is "adapted to," or "configured to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide control elements on the outer end face of the standard part are disposed in such a symmetrical arrangement around the microphone sound aperture, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70. Still

further, the courts have stated that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

With respect to Claims 25 and 26, Ambrose teaches wherein, the dedicated part (Figure 13, #1) is an internal part and the standard part (11) is an external part (when inserted into a user's ear); and the standard part (11) accommodates each of the electronics and a battery (Col. 5, Lines 45-49), the electronics comprising a microphone (15), an amplifier (6), and a loudspeaker (5) within an enclosed volume (enclosed in part #11)

With respect to Claim 27, Levin teaches a pull rod (Figure 2, #38) connected to a housing of the standard part (30), the pull rod (38) configured to remove the hearing aid from the auditory canal (Col. 2, Lines 42-44).

With respect to Claim 31, Levin teaches wherein the standard part (Figure 2, #30) is provided with means (38) for removing said hearing aid from the auditory canal (Col. 2, Lines 42-44).

With respect to Claim 33, Ambrose teaches wherein the cross section of an outer boundary off the outer end face of the standard part (Figure 13, #11) is mirror symmetrical in outside end view.

4. Claims 17 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ambrose (4,852,177) in view of Levin (6,144,750) as applied to claims 12 and 24 above, and further in view of Juneau (6,228,020). Ambrose and Levin are relied upon for the reasons and disclosures set forth above. Ambrose and Levin fail to teach

wherein the outer end face is provided with a switching means and an adjusting means on said surface, the switching means and the adjusting means positioned along a single line bisecting the sound aperture, and the switching means and the adjusting means being positioned on either side of the sound aperture and equidistant from the sound aperture along the single line. Juneau teaches an outer end face (Figure 8, #22) provided with switching means (27) and a connector means or adjustment facility (28) on a surface; the switching means (27) and the adjusting means (28) positioned along a single line and wherein a microphone sound aperture (25) is located near the switch (27) and the adjusting facility (28). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the apparatus of Ambrose, with the apparatus of Juneau to allow for user controlled volume adjustment, as well as the ability to connect to and communicate with a computer for programming of the hearing device. Juneau fails to teach the switching means and the adjusting means positioned along a single line bisecting the sound aperture, and the switching means and the adjusting means being positioned on either side of the sound aperture and equidistant from the sound aperture along the single line.. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to arrange wherein the switching means and the adjusting means positioned along a single line bisecting the sound aperture, and the switching means and the adjusting means being positioned on either side of the sound aperture and equidistant from the sound aperture along the single line., since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70. Further, the courts have stated that

matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

Response to Arguments

5. Applicant's arguments with respect to claims 12, 17, 19, 22-27, 29 and 31-35 have been considered but are moot in view of the new ground(s) of rejection. The Examiner affirms that the obvious combination of Ambrose, Levin and Juneau teach all of the limitations claimed by Applicant.

6. Regarding Applicant's assertion that the prior art fails to teach a standard part configured to connect to said dedicated part regardless of whether said dedicated part is configured to be fitted in the auditory canal of the left ear or the right ear, as required by amended claim, it has been held that the recitation that an element is "configured to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Further, as detailed above, Ambrose teaches the claims standard part (Figure 13, #11) and dedicated part (1). Ambrose further teaches that these hearing aids can be custom fit to a user's ear (right or left ear) (Col. 2, Lines 26-28), and therefore, the parts will fit together regardless of which ear the hearing aid is configured to be used in, otherwise, the device would be inoperable.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy Luks whose telephone number is (571) 272-2707. The examiner can normally be reached on Monday-Thursday 8:30-6:00, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter Benson can be reached on (571) 272-2227. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeremy Luks/
Examiner, Art Unit 2837

/Jeffrey Donels/
Primary Examiner, Art Unit 2837